



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,163	06/25/2001	Mark R. Stiffler	YOR920010116US1	1378

7590 01/25/2007
Timothy M. Farrell
Intellectual Property Law Dept.
IBM Corporation
P.O. Box 218
Yorktown Heights, NY 10598

EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/891,163

Applicant(s)

STIFFLER, MARK R.

Examiner

Jamisue A. Plucinski

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 17-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 62-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 7-9, 12, 13, 16, 62, 65 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Lederer, Jr. et al. (2002/0023109).
3. With respect to Claims 1, 4, 7-9, 12, 13, 16, 62, 65 and 68: Lederer discloses the use of a method, system and program product with instructions for operating a computer comprising the steps and means for:

- a. Storing core requirements applicable to a plurality of countries (Paragraph 0038);
- b. Storing country-specific requirements applicable to respective countries
(Paragraph 0038, Lederer also discloses the use of MSDS, which give standardized shipping requirements, which the examiner considers to be core requirements);
- c. Storing on said computer country-specific summary requirements (Paragraph 0042, the examiner considers the tables to be in the form of a summary);
- d. Receiving a request for a summary report of requirements for a selected country
(see abstract, and Paragraph 0038, by the order form system submitting an order to the GRCS, for country specific requirements, that it is a request for a summary report of requirements);

Art Unit: 3629

e. Providing core as well as country-specific requirements (see abstract and paragraphs 0038 and 0040), it is the examiner's position that if the country specific requirements are provided, then it is inherent that the process of Lederer determines if they are there, due to the fact that how can they be provided if they weren't first determined they were there/stored.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 5, 10 and 14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lederer Jr., et al.

6. With respect to Claims 2, 5, 10 and 14: Lederer discloses the system can be used for multiple shipments, therefore there would have to be a request with a plurality of countries. Furthermore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the request by for multiple countries, since it has been held that a mere multiplicity of parts or steps involves only routine skill in the art. *St. Regis Paper Co. v Bemis Co.* 193 USPQ 8. Therefore it would have been obvious to Lederer to have the request be for multiple carriers, do to the fact that requesting information on multiple countries, would have been at the level of ordinary skill in the art.

Art Unit: 3629

7. With respect to Claims 3, 6, 11, 15, 63, 64, 66 and 67: Lederer discloses providing country specific regulations as well as core regulations, however does not expressly state providing the results in a matrix format. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the results displayed in a matrix format, because Applicant has not disclosed that displaying the results in a matrix format provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the results disclosed in list format, because they are both provided to the user, just organized in different ways. Therefore, it would have been an obvious matter of design choice to modify Lederer to provide the results in matrix format, as specified in Claims 3, 6, 11, 15, 63, 64, 66 and 67.

Response to Arguments

8. Applicant's arguments filed 10/30/06 have been fully considered but they are not persuasive.

9. With respect to Applicant's arguments that Lederer does not anticipate the claimed invention, due to the fact that Lederer is drawn to an order system, not a system for storing country specific requirements: The applicant has stated that Lederer discloses contacting a regulation source to obtain the regulation information, as opposed to storing the information on the system. However, Lederer discloses the regulation source is part of the Lederer system, the GRCS, is part of the entire system of Lederer. As clarified above, Lederer discloses submitting an order to the GRCS, which then looks up the stored country-specific information, the examiner considers the submission of the order to be a form of request for the information. The claims do

Art Unit: 3629

not state where or who the request is coming from, merely states that a request is submitted, therefore broad enough to read on the submission of the order to be the submitting of the request, the system which submits the request to be the requester, and the means of the GRCS which receives the order form, is the means for receiving a request.

10. The applicant is arguing all other rejection, based on 35 USC 103, based on the arguments that Lederer does not disclose anticipate the features of the independent claim. As stated above, it is the examiner's position that Lederer does anticipate the independent claims, therefore the arguments are not considered persuasive and rejections stand as stated above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Krishnan et al. (US 2002/0184068) discloses the use of a system which stores compliance standards and requirements and Jinnett (US 2002/0120477) discloses the use of a system which stores country specific regulations.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

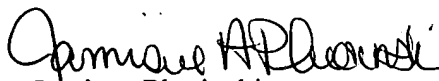
Art Unit: 3629

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jamisue Plucinski
Patent Examiner
Art Unit 3629